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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,140	11/06/2000	Outi Aho	460-009944-US(PAR)	8800
2512	7590	03/29/2005	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			VU, THONG H	
			ART UNIT	PAPER NUMBER

2142

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,140

Applicant(s)

AHO, OUTI

Examiner

Thong H Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Claims 1-52 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-52 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 6,848,008 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Patent '008:

(Claim 1) 1. A method for the transmission of multimedia messages in a communication system from a transmitting terminal (MS1) to a receiving terminal (RH, MS2), which communication system comprises at least a first communication network (NW1), a second communication network (NW2) and

a multimedia message switching centre (MMSC), in which first communication network (NW1) at least a first address type is used as the terminal address and in which second communication network (NW2) at least a second address type is used as the terminal address, and in which system the address of the receiving terminal (RH, MS2) is annexed to said multimedia message, characterized in that the multimedia message is further supplemented with data on the type of said address,

wherein the multimedia message is transmitted from the transmitting terminal (MS1) to said multimedia message switching centre (MMSC), in which the type of the address of the receiving terminal (RH, MS2), is examined, and

said address type is used to select the communication network (NW1, NW2) to be used in the transmission of the message from the multimedia message switching centre (MMSC) to the receiving terminal (RH, MS2).

Application:

(Claim 1) A method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server, the method comprising the steps of:

- Receiving and storing a multimedia message addressed to the wireless terminal at the server, said multimedia message comprising at least one multimedia component,

- Storing information on at least one property of the wireless terminal in the server, characterized in that the method further comprises determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, wherein if there exists one or more such component(s), they are selected for transmission and transmitted to the wireless terminal.

It was clearly that the patent '008 discloses a wireless/radio system using multimedia message, when the multimedia message is detected and selected. In order to transmit and receive the multimedia data, the wireless terminal examines the address type or the properties or the message. If the address type or property is acceptable and message is stored. Thus, the Double Patent rejection is appropriate.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-52 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schloss et al [Schloss 6,249,844 B1].

4. As per claim 1, Schloss discloses a method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server [Schloss, multimedia messaging

services or Web pages described in XML, HTML, by handheld device, abstract], the method comprising the steps of:

- Receiving and storing a multimedia message addressed to the wireless terminal at the server, said multimedia message comprising at least one multimedia component, said multimedia message comprising at least one multimedia component [Schloss, Web content servers provides Web objects using XML, HTML, col col 3 line 60-col 4 line 49, Fig 1-2].

- Storing information on at least one property of the wireless terminal in the server, characterized in that the method further comprises determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, wherein if there exists one or more such component, they are selected for transmission and transmitted to the wireless terminal [Schloss, generate an appropriate version for the client due to the limitation on the processing power or storage capacity of the client device or bandwidth available to the client device, col 4 lines 50-67; the fragment is generated based on the fragment description and the client requirement, characteristics of the requesting devices, col 8 lines 4-35; based on formal descriptors and an object fragment property, col 10 lines 35-45].

5. Claims 19,35,43 contain the similar limitations set forth of apparatus claim 1. Therefore, claims 19,35,43 are rejected for the similar rationale set forth in claim 1.

6. As per claims 2,20,44 Schloss discloses selecting at least one bearer for transmission of the selected component(s) of the multimedia message as inherent feature of Internet.
7. As per claims 3,21 Schloss discloses the selection of at least one bearer is performed in the wireless terminal as inherent feature of Internet and mobile client.
8. As per claims 4,22,36,45 Schloss discloses disclose transmitting a notification message to the wireless terminal comprising information about at least one property of said at least one multimedia component [Schloss, a page message, col 9 lines 45-67].
9. As per claims 5,23 Schloss discloses the selection of a component of a multimedia message for transmission is performed in the server [Schloss, select a subset of the segments, col 4 lines 21-49; col 12 lines 41-43].
10. As per claims 6,24,37,46 Schloss discloses information on at least one property of the wireless terminal is changed to prevent or allow the transmission of at least one component of the multimedia message as inherent feature of change or update the property information [Schloss, updates the reference statistics, the fragment version is updated, an object is updated, col 8 lines 4-67].

11. As per claims 7,25,47 Schloss discloses said information on the properties of the wireless terminal comprises information on the available storage capacity of the wireless terminal [Schloss, bandwidth available, col 4 lines 50-67].

12. As per claims 8,26,48 Schloss discloses said information on the properties of the wireless terminal comprises information on the capability of the wireless terminal to process multimedia components of a particular type [Schloss, creating a identity for a fragment based on fragment property, col 10 lines 35-45].

13. As per claims 9,27,49 Schloss discloses the capability of the wireless terminal to process multimedia components is defined on the basis of the hardware properties of the wireless terminal and/or the properties of the programs installed in the wireless terminal [Schloss, XML, col 4 lines 21-49; Java, col 10 lines 1-12].

14. As per claims 10,28,38 Schloss discloses a maximum time of validity is defined for the information on the properties of the wireless terminal stored in said server as a design choice of set up a time/date field.

15. As per claims 11,50 Schloss discloses a multimedia message addressed to the wireless terminal and comprising at least one multimedia component, is received at the server and a notification message is transmitted to the wireless terminal to indicate that a multimedia message has arrived, characterized in that in the method it is examined

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whether information on the properties of the wireless terminal in question is stored in the server [Schloss, a page message, col 9 lines 45-67], wherein, if said information is not stored in the server, said notification message is supplemented with a request to update the properties of the wireless terminal, wherein information on the properties of the wireless terminal is transmitted from the wireless terminal to the server [Schloss, updates the reference statistics, the fragment version is updated, an object is updated, col 8 lines 4-67].

16. As per claim 12, Schloss discloses examined whether said information on the properties of the wireless terminal stored in the server is valid, wherein if said information is not valid, said notification message is supplemented with a request to update the properties of the wireless terminal [Schloss, a page message, col 9 lines 45-67].

17. As per claims 13,31 Schloss discloses said property information stored in the server is used as the property information of the wireless terminal if the sever does not receive a reply from the wireless terminal to said property update request as inherent feature of updating process.

18. As per claims 14,29,32 Schloss discloses a connection set-up request message is transmitted from the wireless terminal to set up a connection for transmission of at least one multimedia component of a multimedia message addressed to said wireless

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terminal, characterized in that in the method it is examined whether said notification message contains a request to update the properties of the wireless terminal, wherein information on the properties of the wireless terminal is transmitted from the wireless terminal to the server in said connection set-up request [Schloss, a page message, col 9 lines 45-67].

19. As per claims 15,33,42 Schloss discloses a WAP terminal is used as a wireless terminal and that a multimedia message service centre (MMSC) is used as a server [Schloss, Web content servers 40-43, Fig 1].

20. As per claims 16,34,52 Schloss discloses a connection set-up request is transmitted from the wireless terminal to set up a connection for the transmission of at least one multimedia component of a multimedia message addressed to said wireless terminal, characterized in that the connection set-up message used is a Uaprof information transmission message according to WAP specifications, and that the header field is supplemented with a profile-diff header field, if the connection set-up message is supplemented with information on the properties of the wireless terminal, or the header field is supplemented with a profile header field if the connection set-up message is not supplemented with information on the properties of the wireless terminal as inherent feature of multimedia message over Internet and wireless devices [see Gershman reference].

21. As per claim 17, Schloss discloses those components of the multimedia message specified in the property information of the receiving wireless terminal stored in the multimedia messaging system are transmitted *without* a transmission request being transmitted from the wireless terminal as inherent feature of Web servers parsed XML message.

22. As per claims 18,41 Schloss discloses a transmission request is transmitted from the wireless terminal to transmit such multimedia message components which have *not* been specified in the property information of the receiving wireless terminal stored in the multimedia messaging system as inherent feature of multimedia message.

23. As per claim 51, Schloss discloses the wireless terminal is a WAP terminal or mobile node [Schloss, handheld, palm devices, col 1 lines 18-35].

24. As per claims 30,40 Schloss discloses means for examining the validity of said property information of the wireless terminal stored in the server, and means for attaching a request to update the properties of the wireless terminal to said notification message [Schloss, a page message, col 9 lines 45-67].

25. As per claim 39 Schloss discloses interface means (51, 52, 53) for receiving a multimedia message addressed to the wireless terminal, which multimedia message comprises at least one multimedia component, and means (18, 15, 12) for forming a

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notification message for transmission to the wireless terminal to indicate that a multimedia message has arrived [Schloss, a page message, col 9 lines 45-67], characterized in that the server also comprises means to examine whether information on the properties of the wireless terminal in question is stored in the server, control unit means (55) for attaching a request to *update* the properties of the wireless terminal to said notification message, and means (MPLI, RF, ANT) for receiving information on the properties of the wireless terminal at the server [Schloss, updates the reference statistics, the fragment version is updated, an object is updated, col 8 lines 4-67].

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-USP 6,314,302 B1

-USP 6,763,388 B1

-USP 6,522,875 B1

-USP 6,677,858 B1.

-USP 6,647,535 B1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

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Thong Vu
Patent Examiner
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